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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,805

01/22/2004

Kiyokazu Ohtaki

27,540 USA

5392

23307

7590

11/01/2005

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EXAMINER

EDWARDS, ANTHONY Q

ART UNIT

PAPER NUMBER

2835

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,805

Applicant(s)

OHTAKI ET AL.

Examiner

Anthony Q. Edwards

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/22/04; 12/6/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,588,871 to Studholme et al. ("Studholme" hereinafter) in view of U.S. Patent No. 6,788,270 to Suprunov et al. ("Suprunov" hereinafter). Referring to claim 1, Studholme (see Fig. 1) discloses a portable device (12) for receiving an electronic component (i.e., chip) used for communication (see col. 4, lines 31-34), the portable device comprising a portable device body for accommodating the electronic component, the portable device body having an upper case (top portion) and a lower case (lower portion), and a cavity therein (i.e., a place to contain the electronic component in the body). Studholme also discloses the device comprising having a holding member (10) for holding peripheral portions (26) of the portable device body (see col. 4, lines 35-39). Studholme does not specifically teach the upper case having a cavity and the lower case having a cavity.

Suprunov teaches providing a portable device (see Figs. 1-3) for receiving an electronic component, e.g., retractable antenna (101), used for communication, wherein the portable device includes a body (102) having an upper case (112) and a lower case (114), both of which have a cavity (117) and are connected to each other with the cavities opposed to each other (see Fig. 1). It would have been obvious to modify the portable device body of Studholme et al. to include

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separate cavities within the top and bottom housings, respectively, as taught by Suprunov, since the device of Suprunov would provide more depth within the housing of Studholme to allow for additional components, such as a retractable antenna, within the housing.

Referring to claim 2, Studholme in view of Suprunov disclose a portable device as claimed, wherein the holding member (10) holds the upper case and the lower case so as to surround the portable device body. See Fig. 4 of Studholme.

Referring to claim 3, Studholme in view of Suprunov disclose a portable device as claimed, wherein the upper case (112) includes a first flange (not numbered) extending along the peripheral portion of the upper case, the lower case (114) includes a second flange (not numbered) extending along the peripheral portion of the lower case (see Figs. 1-3 of Suprunov), and the holding member (10) has an inner surface (22/24) including an engaging groove engaged with the first and second flanges when the upper case and the lower case are connected to each other (see Fig. 1 of Studholme).

Referring to claims 7-10, Studholme in view of Suprunov disclose a portable device as substantially claimed, except for the holding member including a plurality of holding member pieces of various shapes or designs. It is well known, however, that constructing a formerly integral structure into various elements has been held to involve only routine skill in the art (see MPEP 2144.04; *In re Nerwin v. Erlichman*, 168 USPQ 177, 179). It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the holding member of Studholme, as modified, into two holding member pieces in contact with each other, since the separate pieces would allow some adjustment of the holding device for better contact between the portable device and the holding member.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Studholme in view of Suprunov, and further in view of U.S. Patent No. 6,041,924 to Tajima. Studholme, as modified, teaches the device as substantially claimed, except for further comprising a seal arranged between the upper case and the lower case. Tajima teaches providing a seal (27) within a portable receiver case (see Fig. 4 and the corresponding specification) to provide water-proofing and spill-proofing measures for the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the portable device of Studholme to include a seal within the portable device, as taught by Tajima, to provide water-proof and spill-proof means for the portable device of Studholme as modified.

Claims 5, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studholme in view of Suprunov, and further in view of U.S. Patent No. 6,181,564 to Furusho. Referring to claims 5 and 11, Studholme, as modified, teaches the device as substantially claimed, except for the portable device body being made of a synthetic resin, and the holding member being made of a metal that is more rigid than the portable device body. Furusho teaches providing an IC card or portable device (see Fig. 10) having a frame (23) of synthetic resin and base with side walls (21b) main of metal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the portable device of Studholme to provide synthetic resin and metal in the device, as taught by Furusho, to provide the portable device of Studholme as modified with a durable, light weight housing with a conductive portion therein.

Referring to claim 6, Studholme, as modified, in view of Furusho disclose the device as substantially claimed, except for the holding member being made of metal and covering only the

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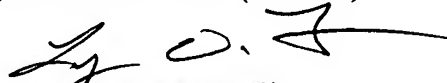
peripheral portions of the upper case and the lower case when the upper case and lower case are connected to each other. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the device of Studholme such that the metal coves only the peripheral portions of the upper case and the lower case, since it has been held that rearranging parts of an invention involves only routine skill in the art. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LYNN FEILD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800